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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

18

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,821

Applicant(s)

LEVINE ET AL.

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the 37 CFR 1.131 declaration swearing behind Camarda, filed on 12/12/2003.

This action is made Non-Final.

2. In the amendment, claims 1-33 are pending in the case. Claims 1, 18, and 24 are independent claims.

3. The rejections of claims 1-2, 5, 6, 9-10, 12-13, 15-17, 24-25, and 27-31 under 35 U.S.C. 102(a) as being anticipated by Camarda et al, "Special Edition Using Microsoft Word 2000", hereinafter Camarda, 1/8/1999, chapter 1, "Creating New Documents", chapter 20, "Inserting Pictures directly, Without Clip Gallery", chapter 29 "Using Powerpoint" have been withdrawn in view of the 37 CFR 1.131 declaration.

4. The rejections of claims 4-5, 18, 21-23, and 32-33 under 35 U.S.C. 103(a) as being unpatentable over Camarda, in view of Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99) have been withdrawn in view of the 37 CFR 1.131 declaration.

5. The rejections of claims 7-8, 19, and 31 under 35 U.S.C. 103(a) as being unpatentable over Camarda, in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10) have been withdrawn in view of the 37 CFR 1.131 declaration.

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6. The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Camarda, in view of "Troubleshooting and configuring the Windows NT/95 Registry", Clayton Johnson, hereinafter Johnson (1997, pp.1-2) has been withdrawn in view of the 37 CFR 1.131 declaration.

7. The rejection of claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Camarda, and in view of Arakawa (Pat.#5,845,076, 12/1/98) has been withdrawn in view of the 37 CFR 1.131 declaration.

8. The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Camarda, in view of Sobol, and further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96) has been withdrawn in view of the 37 CFR 1.131 declaration.

9. The rejection of claim 28 under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, and further in view of TWAIN Specification v. 1.8(10/22/98 as disclosed by Applicants) has been withdrawn in view of the 37 CFR 1.131 declaration.

10. The rejection of claim 26 under 35 U.S.C. 103(a) as being unpatentable over Camarda, in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96) has been withdrawn in view of the 37 CFR 1.131 declaration.

Claim Objections

11. The objections of claims 18-23 have been withdrawn as necessitated by applicants explanation that “data” is plural not singular (page 8, lines 7-12).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 18-23 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 18 recites in limitation (d): “converting said data representing the selected image into a compressed format unless said data are already in the compressed format”.

Applicants stated that support for compressing images is found in the specification in page 47, line 33-page 48, line 3 (page 8, lines 19-26). The above limitation is not found in these passages of the specification as indicated by the applicants. This portion of the specification refers to the negotiating compression levels. The examiner cannot see how the negotiation of compression levels translate into “converting said data representing the selected image into a compressed format unless said data are already in the compressed format”. As I understand, the limitation states that the image is compressed if it has not already been compressed, and this is not taught by the portion of the specification cited by applicants.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2, 5, 6, 9-10, 12-13, 15-17, 24-25, and 27-31 rejected under 35 U.S.C. 102(b) as being anticipated by Corel Wordperfect 6.1, 1996, hereinafter Wordperfect, "Scan Images into Wordperfect", and "Scanner Setup", "Image Settings", and "Image Tools" printouts.

Regarding independent claim 1, Wordperfect teaches the acquisition, and insertion of a scanned image(s), from a TWAIN scanner, under control of a wordprocessing application, into a textual document(s) located in a Wordprocessing application (pages 1, 5). In other words, the scanner is activated once user selects the "Acquire" command from the "Insert" menu. The insertion of the scanned image(s) into the textual document(s) is done directly from the scanner, that is without saving the image into a permanent file in the computer memory prior to inserting the file into the textual document.

Claim 3 is directed towards a method for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 15, which depends on claim 12, Wordperfect discloses the automatic scan of images into a document using only TWAIN enabled scanners, thereby determining whether the device(s) is TWAIN compliant, and only using a single user selection of an “acquire” option from an insert menu (pages 1-2).

Claim 16 is directed towards a computer-readable medium for storing the steps found in claim 1, and therefore is similarly rejected.

Claims 24-25 are directed towards a system for implementing the steps found in claims 1, and 1 respectively, and therefore are similarly rejected.

Regarding claim 27, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) produced with a wordprocessor—*presentation design application* (pages 1-2, 5).

Regarding claim 28, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) (pages 1-2, 5).

Claim 29 is directed towards a system for implementing the steps found in claim 15, and therefore is similarly rejected.

Regarding claim 30, which depends on claim 24, Wordperfect discloses the automatic scan of images into a document using only a using a single user selection of an “acquire” option from an insert menu (page 1).

Regarding claim 31, which depends on claim 24, Wordperfect discloses allowing a user to customize or enhance the image settings to be inserted into the document. This enhancement is done from within the wordprocessor (page 7).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of “Ulead PhotoImpact 3.0” User Guide for Windows 95 and Windows NT 3.51, hereinafter Photoimpact, Ulead Systems, 1996, pp.104-107, 111-114, 162-167.

Regarding claim 2, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *a list of all image source devices in communication with the computer*. However, Photoimpact discloses the selection of a specific device from a list

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including all the devices connected to a pc for scanning images into the pc (page 162, lines 28-38). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the selection of one device out of all the devices connected to the pc, because the computer does not know which device the user wants to use to acquire the image, the user must choose, when there are more than one device connected to the computer.

Regarding claim 6, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *(a) selecting at least one image enhancement criterion, and (b) enhancing said captured image based on said image enhancement criterion, prior to inserting said data representing the image into said document*. However, Photoimpact discloses the setting of image calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer-- *prior to inserting said data representing the image into said document* (page 164, line 14-page 167). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 9, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *the application program negotiating with the image*

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source device that is active to determine a set of image capture parameters the control said image source device when acquiring said image. However, Photoimpact discloses the setting of postprocessing options for adjusting, and enhancing images to be scanned into the computer (page 165, lines 4-67). In other words, once the postprocessing options are selected, the photoimpact application negotiates with the scanning device the straightening, cropping, removing moiré, etc., of the image. The application program tells the scanner how to enhance the image, if so needed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance.

Regarding claim 10, which depends on claim 9, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *the set of image capture parameters are negotiated based in part on the capabilities of said image source device.* However, Photoimpact discloses the setting of calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer (page 164, line 14-page 167). In other words, once the postprocessing options are selected, the photoimpact application negotiates with the scanning device the straightening, cropping, removing moiré, etc., -- *capture parameters are negotiated based in part on the capabilities of said image source device*-- of the image. This calibration is also based in part on the user's input. It would have been obvious to a person of ordinary skill in the art at the

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time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 12, which depends on claim 1, Wordperfect discloses the scanning of images directly into a document (page 1). Wordperfect fails to explicitly disclose: *determining from within the application program whether the image source device that is active is able to perform an automatic image scan*. However, Photoimpact discloses the display of an error message, if a selected device is not a TWAIN device, and if there is a TWAIN device, but it is not properly configured, then a dialog box containing configuration options appears (page 163, line 8-17). In other words, when a user selects the acquire image button, instead of being able to automatically scan the image, the user is informed the automatic scan cannot be performed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses above the benefit of informing the user whether or not the device is properly configured.

Claim 17 is directed towards a computer-readable medium for storing the steps found in claim 12, and therefore is similarly rejected.

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18. Claims 4-5, 18, 21-23, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99).

Regarding claim 4, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *scanning a graphic source that has defined edges, further comprising the steps of automatically detecting the edges of the graphic source, and cropping the image at the edges of the graphic source to exclude any portion of a scanned field.* However, Sobol discloses the selection of a specific portion of an image detecting the edges, thereby leaving unwanted data out, and cropping it to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches allowing the benefit of customizing a desired image by allowing the user to crop and select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired.

Regarding claim 5, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *converting the data representing the image into a compressed format prior to inserting the data into the document.* However, Sobol discloses the

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compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches above the benefit of reduction of memory and processing time required to process the image.

Regarding independent claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, under control of a wordprocessing application, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). The scanning, and insertion of the images is made using a scheme or a number of prescribed steps.

Moreover, Wordperfect teaches the insertion of scanned images directly into a textual document without saving the images to a file prior to inserting them into the document (page 1). Wordperfect fails to explicitly teach *converting said data representing the selected image into a compressed format unless said data are already in the compressed format, and (e)*. Sobol discloses the compression of image(s), not compressed, before inserting in a document (col.4, lines 37-col.5, line 18). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combine the teachings of Wordperfect, and Sobol, because Sobol teaches above the benefit of reducing the amount of memory and processing time require to store, and process the images.

Regarding claim 21, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual

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document(s) located in the Wordprocessing application, such as a slide presentation made up of individual slides (pages 1-2, 5).

Regarding claim 22, which depends on claim 18, Wordperfect teaches the editing, and adjusting—*enhancing*-- of scanned images, using image editing tools incorporated within the wordprocessor (pages 3-4).

Claim 23 is directed towards a computer-readable medium for storing the steps found in claim 18, therefore is similarly rejected.

Regarding claim 32, which depends on claim 24, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2).

Wordperfect fails to explicitly disclose: *the image is acquired by scanning a graphic source that has edges of the graphic source so as to automatically crop a scanned field included within the graphic source in the image, the image being so cropped prior to the data representing the image being inserted into the document.* However, Sobol discloses the selection of a specific portion of an image prior to inserting the image into a document, detecting the edges, thereby leaving unwanted data out, and cropping them to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches above, allowing the benefit of customizing a desired image by allowing the user to crop and

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select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired by a user.

Claim 33 is directed towards a system for implementing the steps found in claim 5, and therefore is similarly rejected.

19. Claims 7-8, 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10).

Regarding claim 7, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a contrast level of the image that is adjusted to enhance a brightness*. However, Photoshop teaches the altering of an image contrast/brightness (p.8,L.1-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the benefit of increasing the legibility of a textual document. This would increase the legibility of the image obtained by the scanner, or device.

Regarding claim 8, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual

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document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a color level of the image...based on a gamma correction algorithm*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the benefit of customizing of an image to be compatible with the colors of a specific computer platform. This would increase the legibility of the image obtained by the scanner, or device.

Regarding claim 19, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the application program is a word processing application, and the plurality of images are inserted into the document as a plurality of tiled images*. However, Photoshop teaches the creation of graphics using a tiling technique (p.4,L.14-p.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop because Photoshop teaches above the benefit of the use of tiled images as a web page background, thereby enhancing a web page created with the wordprocessor.

Regarding claim 31, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual

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document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancing the quality of the captured image from within the application, the captured image quality being enhanced prior to inserting the data representing the image into the application program document*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the customization of an image to be compatible with the colors of a specific computer platform.

20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of “Troubleshooting and configuring the Windows NT/95 Registry”, Clayton Johnson, hereinafter Johnson (1997, pp.1-2).

Regarding claim 11, which depends on claim 10, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *a set of capabilities are associated with the image source devices...and are stored in an operating system registry*. However, Johnson teaches the settings and capabilities of hardware being stored in a computer’s Windows registry (p.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Johnson, because Johnson teaches above storing hardware information in a registry to enable an operating system to control and run those devices.

21. Claim 14 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, and in view of Arakawa (Pat.#5,845,076, 12/1/98).

Regarding claim 14, which depends on claim 12, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *setting an error flag*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status.

Furthermore, Wordperfect fails to explicitly disclose: *clearing the error flag if the automatic scan is successful, and evaluating the error flag..if the error flag has not been cleared*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process, and therefore the scanning cannot be completed (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status of a scanner, so that a user would be informed as to the status of the scanning job.

22. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Sobol, and further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 20, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the plurality of inserted images are inserted into the spreadsheet document as a plurality of cascaded images*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

23. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 26, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 6-7). Wordperfect fails to explicitly disclose: *the application program is a spreadsheet application*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines

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1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

24. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of TWAIN specification version 1.8, 110/22/98, hereinafter Twain (IDS filed on 8/23/99).

Regarding claim 13, which depends on claim 12, Wordperfect teaches the scanning of an image into a document by simply choosing an "Acquire Image" menu option (page 1).

Wordperfect fails to explicitly disclose: *the device that is active has an X, and a Y resolution, and includes a driver that provides a user interface for selecting image capture parameters, (a) confirming that said image source device can control its X resolution; (b) confirming that said image source device can control its Y resolution; (c) confirming that the user interface can be bypassed, wherein an affirmative answer to all of the steps of confirming indicates that said image source device can perform the automatic image scan.* However, Twain teaches negotiating capabilities, such as X, Y resolution supported by a device (page 69, page 71, 14-31). Twain also teaches negotiating capabilities, such as the setting of certain x/y resolution, between a source device, and an application leads to a modification of a dialog, such as the graying out or *bypassing* of the dialog (page 116, lines 7-34, page 70, part 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Photoimpact and Twain, because Twain teaches the benefit of giving control to TWAIN applications (page 65, lines 16-20).

Response to Arguments

25. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection. The applicants submit that even without the 37 CFR – swearing behind—declaration, Camarda does not disclose or suggest the claims (page 9, lines 18-29). The applicants are directed towards the rejections of these newly amended claims in light of the newly found prior art.

Regarding claims 4-5, 18, 21-23, and 32-33, the applicants submit that Camarda is no longer available as a prior art reference, and the remaining prior art does not make up for the limitation which were taught by Camarda (page 10, lines 4-7). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Regarding claims 7-8, 19, and 31, the applicants submit that Camarda is no longer available as a prior art reference, and the remaining prior art does not make up for the limitation which were taught by Camarda (page 10, lines 9-14). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Regarding claim 11, the applicants submit that Camarda is no longer available as a prior art reference, and the remaining prior art does not make up for the limitation which were taught

by Camarda (page 10, lines 19-22). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Regarding claim 14, the applicants submit that Camarda is no longer available as a prior art reference, and the remaining prior art does not make up for the limitation which were taught by Camarda (page 10, lines 26-28). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Regarding claim 20, the applicants submit that Camarda is no longer available as a prior art reference, and Hearn, and the remaining prior art does not make up for the limitation which were taught by Camarda (page 11, lines 49-7). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Regarding claim 26, the applicants submit that Camarda is no longer available as a prior art reference, and the remaining prior art does not make up for the limitation which were taught by Camarda (page 11, lines 11-12). The Applicants are directed towards the rejections of these newly amended claims in view of the newly found prior art.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "TWAIN White Paper", 1996, <http://www.twain.org>, pp.1-4.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "TWAIN White Paper", 1996, <http://www.twain.org>, pp.1-4.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Any response to this Action should be mailed to:

Director United States Patent and Trademark Office
Washington, D.C. 20231

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


CESAR B PAULA
Patent Examiner
Art Unit 2178

3/8/04